REMARKS

In response to the Office Action mailed on December 12, 2005, Applicants amended claims 1, 25, 27, and 31, cancelled claims 11-16, 18-24, and 28, and added new claims 38 and 39. Applicants also amended the specification. Claims 1-10, 17, 25-27, and 29-39 are presented for examination.

Applicants filed Information Disclosure Statements in this application on February 18, 2005, April 22, 2005, October 17, 2005, and November 18, 2005, but have not yet received confirmation that the references cited in these Information Disclosure Statements have been reviewed. PAIR indicates that the Information Disclosure Statements have all been received and scanned into the Image File Wrapper for this application. Applicants therefore request that the Examiner provide confirmation that the references cited in these Information Disclosure Statements have been reviewed.

Applicants have deleted "DACRON®" and "Kevlar®" from claim 27, and have replaced "Kevlar®" with the type of polymer (poly-paraphenylene terephthalamide) that is sold under the Kevlar® trademark. Applicants also have added new claim 38, which covers the type of polymer (polyethylene terephthalate) that is sold under the Dacron® trademark.

The Examiner rejected claims 1-37 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,192,301 ("Kamiya"). As amended, claims 1-10, 17, 25-27, and 29-37 cover a composition including an embolic particle including a shape memory material, where the particle is generally spherical. Kamiya fails to disclose an embolic particle that is generally spherical. Accordingly, Kamiya does not anticipate claims 1-10, 17, 25-27, and 29-37, and Applicants request that the rejection of claims 1-10, 17, 25-27, and 29-37 as anticipated by Kamiya be withdrawn.

The Examiner also rejected claims 1-37 under 35 U.S.C. § 102(b) as anticipated by A. Laurent, "Materials and Biomaterials for Interventional Radiology", *Biomed. & Pharmacother.* 1998: 52: 76-88 ("Laurent"). As amended, claims 1-10, 17, 25-27, and 29-37 cover a composition including an embolic particle including a shape memory material, where the particle is generally spherical.

The Examiner is reminded that, "'Anticipation' requires that the identical invention was already known to others, that is, that the claimed invention is not new." (C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1360 (Fed. Cir. 1998).) Laurent provides an analysis of many different types of interventional devices, including embolic particles (see Laurent at 80) and stents that are formed of Nitinol, a shape memory material (see Laurent at 78). But Laurent's discussion of embolic particles in one section of his article and of Nitinol in a different section of his article does not make the identical invention of an embolic particle including a shape memory material known to others, and thus does not anticipate claims 1-10, 17, 25-27, and 29-37 under 35 U.S.C. § 102.

For example, in Ecolochem, Inc. v. Southern California Edison Co., the Federal Circuit held that claims covering a deoxygenation process including a first step of contacting a liquid containing dissolved oxygen and hydrazine with a bed of activated carbon, and a second step including passing the liquid through a strong acid cation exchange resin and a strong base anion exchange resin, were not anticipated by a reference that separately disclosed these steps, but that did not disclose one process including both of these steps. (See Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d 1361, 1366-69 (Fed. Cir. 2000).) In one section of the reference, the authors disclosed a deoxygenation process including deoxygenating water by hydrogen, and then passing the deoxygenated water through a mixed bed (an acid cation exchange resin and a base anion exchange resin). (See id.) In a separate section of the reference, the authors disclosed a deoxygenation process including deoxygenating water by hydrazine. (See id.) However, the authors did not disclose subsequently passing the deoxygenated water through a mixed bed. (See id.) The court agreed with another court's earlier decision that "'[n]othing in the . . . reference expressly teaches the use of a mixed bed ion exchange resin following the hydrazine/carbon process'", and held that the reference therefore did not anticipate the claims. (See id. at 1368-69.) Similarly, Laurent's discussion of a Nitinol stent in one section of his article, and of embolic particles in a different section of his article, is not an anticipatory disclosure of an embolic particle including a shape memory material under 35 U.S.C. § 102. Accordingly, Laurent does not anticipate claims 1-10, 17, 25-27, and 29-37, and Applicants

request that the rejection of claims 1-10, 17, 25-27, and 29-37 as anticipated by Laurent be withdrawn.

New claims 38 and 39 depend from claim 1, and are patentable at least for the reasons provided above.

Applicants believe that claims 1-10, 17, 25-27, and 29-39 are in condition for allowance, which action is requested.

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Respectfully submitted,

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